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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,982	08/28/2006	Ikuo Mimura	03933.000600.	2590

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FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

EXAMINER

HIGGINS, GERARD T

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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03/18/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/590,982	MIMURA, IKUO	
	Examiner	Art Unit	
	GERARD T. HIGGINS	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/12/2010 has been entered.

Response to Amendment

2. Applicant's amendment filed 02/12/2010 has been entered. Currently claims 1-3 and 7-9 are pending and claims 4-6 are cancelled.

Claim Rejections - 35 USC § 112

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claim 1, the Examiner does not find support to claim a “display device comprising...an auxiliary substrate” in the specification as originally filed. This is clear from at least page 14, lines 5-7 wherein applicants’ specification describes that the “display device...can be adhered to another auxiliary substrate.” This clearly shows that the display device does not “comprise” the auxiliary substrate as claimed.

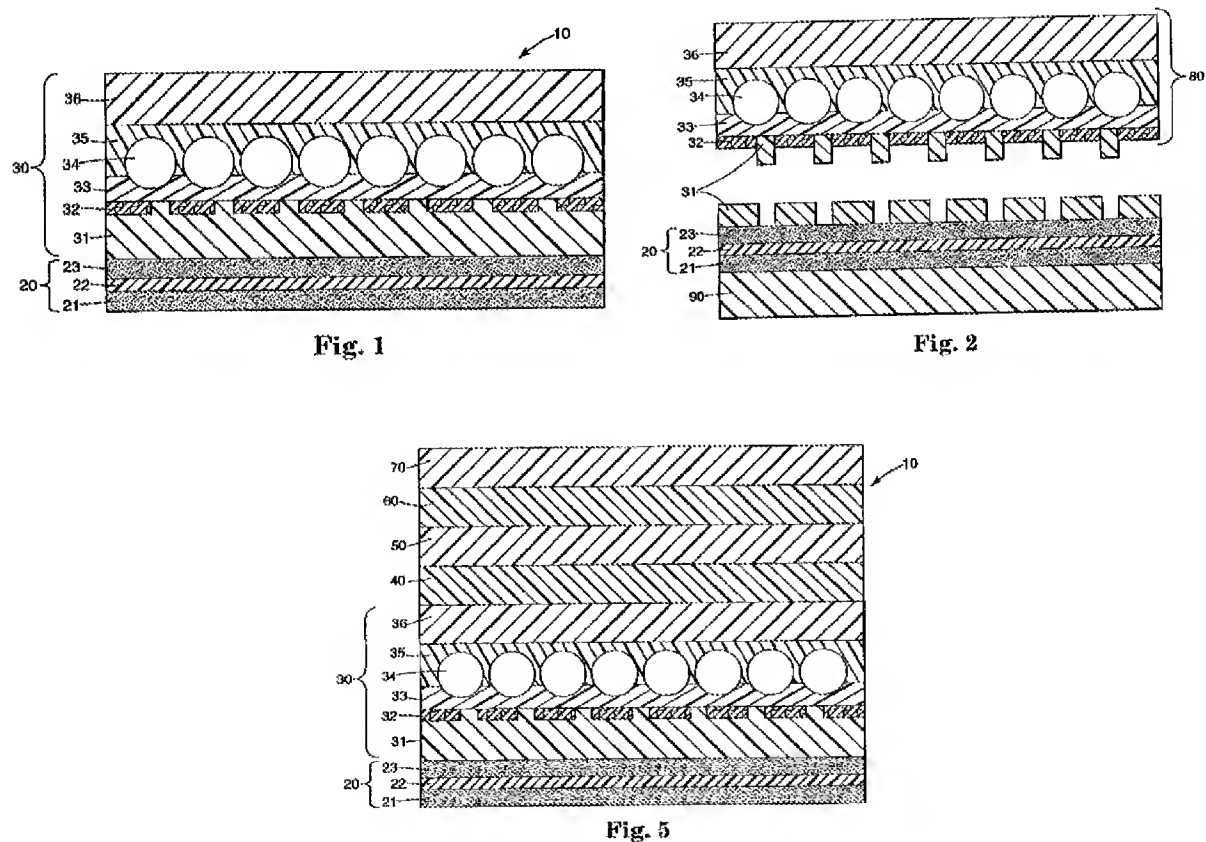
With further regard to claim 1, the Examiner does not find support to claim that “said auxiliary substrate being *adapted to be* mechanically fixed on an installation substrate” in the specification as originally filed. There is no support in applicants’ specification for the auxiliary substrate “being adapted” to be mechanically fixed. This broadens the claim to include features that are not supported. This rejection will be withdrawn if the phrase “adapted to be” is cancelled.

With regard to claim 1, the Examiner does not find support to claim that “said auxiliary substrate wrapping-up the substrate-adhesive layer” in the specification as originally filed. It is clear from at least page 14, lines 13-15 that the auxiliary substrate wraps-up the “display device” and not the substrate-adhesive layer individually. This rejection will be withdrawn if the limitations are changed to state either “said auxiliary substrate wraps-up the display device” or “said auxiliary substrate being capable of wrapping-up the display device.”

Claim Rejections - 35 USC § 103

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hingsen-Gehrmann et al. (US 2002/0142121) in view of Yamamoto et al. (US 2002/0036359) and Chirhart et al. (4,919,741).

With regard to claim 1, Hingsen-Gehrmann et al. disclose the tamper-indicating articles, which read on applicants' display device, of Figures 1, 2, and 5.

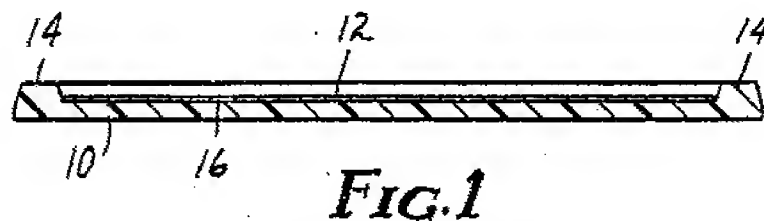


The device is comprised of a top film **70**, which reads on applicants' surface-protective layer, a print layer **60**, which reads on applicants' information display layer, the layers **33** through **36**, which together read on applicants' light-reflective resin sheet, and an

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adhesive layer **20**, which reads on applicants' substrate adhesive layer [0034]-[0052], [0069] and [0079]. There is a reflective layer **31**, which reads on applicants' specular reflective layer, that is overlapping the light-reflective resin sheet via a release layer **32**, which reads on applicants' destructive layer installed on one side thereof, and the device is installed on an substrate **90**, which reads on either of applicants' auxiliary substrate or installation substrate, via the adhesive layer; further, when the device is tampered with it results in the structure seen in Figure 2 [0072]. Hingsen-Gehrmann et al. teach that their release layer is preferably made of polyesters [0059]. There is a destructive effect wherein separation takes place between the release layer and one of the other layers constituting the retroreflective sheet; however, the Examiner notes that Hingsen-Gehrmann et al. fail to disclose an auxiliary substrate having a size larger than the display device so as to be capable of wrapping-up the display device, and they also fail to disclose the polymer resins of the destructive layer as claimed.

Chirhart et al. disclose an information plate having retroreflective sheeting of their Figure 1.



The article is comprised of a retroreflective sheeting **12**, which reads on applicants' display device, and plate blank **10**, which read on applicants' auxiliary substrate (col. 3, line 65 to col. 4, line 2). It is clear from the Figure that the auxiliary substrate is a size larger than said display device and the auxiliary substrate is capable of wrapping-up

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said display device. This article is a license plate (col. 1, lines 15-17), which will be installed somewhere on a car, typically a bumper. The fact that a license plate is installed, i.e. mechanically fixed, on a car or a car bumper is intrinsic in the reference and would be known to those of ordinary skill in the art. The car or its bumper would read on applicants' installation substrate.

Since Hingsen-Gehrmann et al. and Chirhart et al. are drawn to display devices including retroreflective elements; it would have been obvious to one having ordinary skill in the art at the time the invention was made to adhere the display device of Hingsen-Gehrmann et al. onto the auxiliary substrate of Chirhart et al. The motivation for doing so would be to provide greater strength and rigidity to the retroreflective sheet (col. 3, lines 60-64). The display device with the print layer of Hingsen-Gehrmann et al. in view of the teachings of the information plate having retroreflective sheeting of Chirhart et al. being used as a license plate (col. 1, lines 15-17) reads on applicants' requirement that the display device is "being a number plate." One of ordinary skill would know to make a license plate having a combination of numbers and letters using the retroreflective sheeting of Hingsen-Gehrmann et al.

Yamamoto et al. disclose that resins based on cyclopentane ring residues and polyester resins are exchangeable in optical articles [0025] to [0035]. They state that the residues are known for toughness and transparency, both important qualities for optical articles [0026] and [0033]. The hydrocarbon based residues has a small optical anisotropic effect [0042]. One of ordinary skill would recognize that all of these effects would be crucial in retroreflective display articles.

Since Hingsen-Gehrmann et al. and Yamamoto et al. are both drawn to optical articles; it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the hydrocarbon based resins such as cyclopentane, norborene, or adamantane of Yamamoto et al. for the polyester based resins of Hingsen-Gehrmann et al. The motivation for doing so would be to result in an optical article in excellent transparency, toughness, and small optical anisotropic effects.

6. Claims 2, 3, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hingsen-Gehrmann et al. (US 2002/0142121) in view of Yamamoto et al. (US 2002/0036359) and Chirhart et al. (4,919,741), as applied to claim 1, and further in view of Mimura (WO 02/103629), wherein the national stage application US 2004/0218273 will be used as a direct English translation.

With regard to claims 2 and 3, Hingsen-Gehrmann et al. in view of Yamamoto et al. and Chirhart et al. disclose all of the limitations of applicant's claim 1 in section 5 above, including disclosing glass micro beads in the light-reflective resin sheet **34** [0055]; however they fail to disclose a focusing layer in between a specular reflective layer and said glass micro beads. They also fail to disclose an embodiment wherein the light-reflective resin sheet is a microprismatic retroreflective sheeting layer formed of microprisms and a specular reflective layer installed on the reflective side faces of the microspheres.

Mimura disclose cube-corner prismatic retroreflective elements in a light reflective resin sheet [0028] to [0030]. Mimura also discloses enclosing micro glass

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beads in a thin film resin layer "for adjusting their focal distance where necessary"

[0032]. This reads on applicants' focusing layer.

Since Hingsen-Gehrmann et al. in view of Yamamoto et al. and Chirhart et al., and also Mimura are drawn to display devices using retroreflective sheets; it would have been obvious to one having ordinary skill in the art at the time the invention was made to add in a focusing layer as taught by Mimura into the device of Hingsen-Gehrmann et al. such that one could properly tune the focal length to arrive at a display device that would properly reflect light back at the correct angle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cube-corner prismatic retroreflective elements of Mimura in place of the glass beads in the light reflective resin sheet of Hingsen-Gehrmann et al. The results of these substitutions would have been predictable to one having ordinary skill; further, the elements are known equivalents and would perform predictably.

With regard to claims 7-9, Hingsen-Gehrmann et al. in view of Yamamoto et al. and Chirhart et al. disclose all of the limitations of applicant's claims 1 in section 13 above; however, they fail to disclose the RFID communication device and antenna installed on the back of the display device; specifically, wherein a section of the specular reflective layer is removed in order to install said RFID communication device and antenna. They also fail to disclose a situation wherein the specular reflective layer is partially installed in order to form the communication device.

Mimura disclose a RFID communication device with an antenna attached to the back of the display device at [0102] to [0109]; further, they disclose removing a portion

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of the specular reflective layer in order to improve the sensitivity of the antenna/communication device [0108] to [0109]. Mimura also discloses a situation wherein the specular reflective layer is formed as the antenna itself [0107].

Hingsen-Gehrmann et al., Yamamoto et al., Chirhart et al., and Mimura are all drawn to optical display media; it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine in the RFID communication device onto the back of the display device of Hingsen-Gehrmann et al. in view of Yamamoto et al. and Chirhart et al. The results would have been completely predictable to one having ordinary skill; specifically, it would prevent identity thefts, wherein thieves use the RFID to pay tolls illegally.

With regard to the functional limitations in claim 9 that "when the display device is peeled off from the installation substrate, the specular reflective layer is broken and loses its antenna function," intended use limitations are not dispositive of patentability. The device of Hingsen-Gehrmann et al. in view of Yamamoto et al. and Chirhart et al. and further in view of Mimura disclose a display device identical to that claimed, and therefore the Examiner deems it capable of performing the intended use.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 7-9 are directed to an invention not patentably distinct from claims 1-5 and 8-10 of commonly assigned Application No. 10/569,869. Specifically, see section 8 below.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application No. 10/569,869, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon

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the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

8. Claims 1-3 and 7-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 8-10 of copending Application No. 10/569,869 in view of Chirhart et al. (4,919,741) and Mimura (WO 02/103629).

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both related to a retroreflective sheeting that is comprised of a surface protective layer (surface layer), a substrate-adhesive layer (adhesive layer), and a light-reflective resin sheet (retroreflective element layer). The destructive layer is installed in between the specular reflective layer (see copending claim 10) and micro glass beads (focusing layer) of the retroreflective element. The resins that comprise the destructive layer overlap. When the device is peeled from a substrate it will peel such that the specular reflective layer remains on the substrate; however, the copending application fails to disclose the device is useful as a display device or a number plate, an information display layer, an auxiliary substrate, an installation substrate, a microprismatic retroreflective sheeting layer formed of microprisms, and the RFID structure of pending claim 7-9.

Applicant's attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those

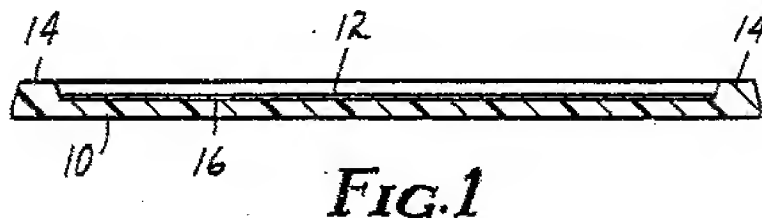
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portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent.

(underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438,164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to page 1, lines 21-27 of the specification of copending Application No. 10/569869 which discloses that the retroreflective sheeting is useful as traffic signs or a number plate, which reads on the presently claimed display device. Additionally, on page 6, lines 29-32 there is a disclosed a printed layer that reads on the presently claimed information display layer; therefore, it would have been obvious to one of ordinary skill in the art to make the copending retroreflective sheeting into a display device or number plate, including an information display layer as presently claimed. The motivation for including these is that retroreflective elements are ubiquitous in the field of road signage because they are seen at long distances; further, indicia in such retroreflective display elements would provide information that was also seen at long distances.

Chirhart et al. disclose an information plate having retroreflective sheeting of their Figure 1.



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The article is comprised of a retroreflective sheeting **12**, which reads on applicants' display device, and plate blank **10**, which read on applicants' auxiliary substrate (col. 3, line 65 to col. 4, line 2). It is clear from the Figure that the auxiliary substrate is a size larger than said display device and the auxiliary substrate is capable of wrapping around or wrapping-up said display device. This article is a license plate (col. 1, lines 15-17), which will be installed somewhere on a car, typically a bumper. The fact that a license plate is installed on a car or a car bumper is intrinsic in the reference and would be known to those of ordinary skill in the art. The car or its bumper would read on applicants' installation substrate.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to adhere the retroreflective sheeting of the copending claims onto the auxiliary substrate and installation substrate as taught by Chirhart et al. The motivation for doing so would be to provide greater strength and rigidity to the retroreflective sheet (col. 3, lines 60-64).

Mimura disclose cube-corner prismatic retroreflective elements in a light reflective resin sheet [0028] to [0030].

Mimura disclose a RFID communication device with an antenna attached to the back of the display device at [0102] to [0109]; further, they disclose removing a portion of the specular reflective layer in order to improve the sensitivity of the antenna/communication device [0108] to [0109]. Mimura also discloses a situation wherein the specular reflective layer is formed as the antenna itself [0107].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cube-corner prismatic retroreflective elements of Mimura in place of the glass beads in the light reflective resin sheet of the pending claims. The results of these substitutions would have been predictable to one having ordinary skill; further, the elements are known equivalents and would perform predictably.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine in the RFID communication device onto the back of the display device of the pending claims. The results would have been completely predictable to one having ordinary skill; specifically, it would prevent identity thefts, wherein thieves use the RFID to pay tolls illegally.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1-3 and 7-9 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/569,869 in view of Shimizu (JP 10-055147) and Mimura (WO 02/103629), which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application. Please see section 8 above for the rationale behind this rejection.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention “by another,” or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Response to Arguments

10. Applicant's arguments filed 02/12/2010 have been fully considered but they are not persuasive.

Applicants argue that their claims originally recited that the display device included an auxiliary substrate.

The Examiner respectfully disagrees and notes the rejection set forth in section 4 above, wherein the “display device comprising...an auxiliary substrate” is not supported by the specification as originally filed.

Applicants argue that the Examiner has not taught that the display device is a “number plate.”

The Examiner respectfully disagrees and notes that the retroreflective sheeting of Hingsen-Gehrmann et al. has a print layer; furthermore, the display device with the print layer of Hingsen-Gehrmann et al. in view of the teachings of the information plate

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having retroreflective sheeting of Chirhart et al. being used as a license plate (col. 1, lines 15-17) reads on applicants' requirement that the display device is "being a number plate." One of ordinary skill would know to make a license plate having a combination of numbers and letters using the retroreflective sheeting having a print layer of Hingsen-Gehrmann et al.

Applicants argue that the plate blank of Chirhart et al. does not "wrap-up anything."

The Examiner respectfully disagrees and notes that the verb "wrap-up" is defined by Merriam-Webster Online as "**2b**: cinch" and the verb "cinch" is defined as "**1b**: to fasten tightly." The plate blank **10** of Chirhart et al. surrounds the retroreflective sheeting and the retroreflective sheeting is adhered to the plate blank. The Examiner deems that the display device of Hingsen-Gehrmann et al. adhered to the plate blank of Chirhart et al. would read on the claimed limitations of the "auxiliary substrate wrapping-up the substrate-adhesive layer" as claimed.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-Th 10am-8pm est. (Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Ruthkosky/
Supervisory Patent Examiner
Art Unit 1794

GERARD T. HIGGINS
Examiner
Art Unit 1794

/G. T. H./
Examiner, Art Unit 1794